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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/676,367	10/01/2003	Theodore Nathanson	NATHANSON et al.-PA-2	3220

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EXAMINER

HOGUE, GARY CHAPMAN

ART UNIT PAPER NUMBER

3611

DATE MAILED: 11/28/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/676,367	Applicant(s) NATHANSON ET AL.	
	Examiner Gary C. Hoge	Art Unit 3611	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 August 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6 and 8-11 is/are pending in the application.
- 4a) Of the above claim(s) 5, 6 and 11 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4 and 8-10 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

1. Claims 5, 6 and 11 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected species, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on February 26, 2005.

Applicant elected Species II, which is the embodiment illustrated in Fig. 3. Although Applicant indicated in the response filed February 26, 2005, that only claim 7 did not read the elected embodiment, a reading of the claims shows that claims 5 and 6 include features that are unique to embodiments other than the one illustrated in Fig. 3. Therefore, these claims do not read on the elected embodiment and have been withdrawn.

Previously, claims 4 and 8-11 had also been withdrawn, but Applicant has amended those claims such that they now read on the elected embodiment.

Regarding claim 5, this claim recites: "front sheet and rear sheet permanently bonded at first side edge, bottom edge, *and second side edge*" (emphasis added). In the elected embodiment, the sheets are only bonded at the first side edge and the bottom edge. The second side edge is not bonded, as can clearly be seen in Fig. 3. Therefore, claim 5 is properly withdrawn from consideration as being drawn to a nonelected species.

Regarding claims 6 and 11, these claims recites "a plurality of embossed index tabs" (claim 6) and "a plurality of index tabs" (claim 11). This feature is not mentioned in the description of the elected embodiment. Rather, it is mentioned on page 17 in conjunction with the embodiment of Fig. 4. Therefore, claims 6 and 11 are properly withdrawn from consideration as being drawn to a nonelected species.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claim 6 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The recitation that the “top edge and first side edge of front sheet and top edge and second side edge of back sheet are not bonded” appears to be misdescriptive. It appears that the claim should read: “top edge and first side edge of front sheet and top edge and first side edge of back sheet are not bonded.”

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which the subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

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6. Claim 1 is rejected under 35 U.S.C. 103(a) as being unpatentable over Morgan (4,301,919) in view of Mayer (5,667,248) and Hillemann et al. (2003/0211268).

Morgan discloses a method comprising the steps of selecting one or more substantially flexible indicia **14, 16** from an indicia source, each of the indicia having indicia information to be displayed, selecting one or more substantially rigid holders **12** from a holder source, each of the holders having holder information to be displayed; applying one or more of the indicia to each of the holders, to form a combined indicia and holder; selecting a display **20** from a display source for each of the holders selected, wherein the display comprises a pocket portion, inserting the combined indicia and holder into the pocket portion of the display, and displaying the displayed indicia information and displayed holder information. Morgan does not disclose that there is hidden indicia on either the flexible indicia or the rigid holder. However, it is well known to provide instructional indicia that is intended to be hidden during use. Mayer shows an example of such indicia. It would have been obvious to one having ordinary skill in the art at the time the invention was made to include hidden instructional indicia (e.g., "Place stamp here," or "Insert under tab", etc.) to either or both of the indicia and/or the holder, as taught by Mayer, in order to instruct the user in the proper use of the invention. Further, the display disclosed by Morgan does not include a flap tab portion with reusable adhesive attached thereto. Hillemann et al. teaches that it was known to provide a transparent display with a flap having a reusable adhesive in order to protect the contents of the display by releasably sealing them inside the display. It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the display disclosed by with a flap having an adhesive portion in order to protect the contents of

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the display by releasably sealing them inside the display. When the flap is sealed the adhesive portion is concealed. Conversely, when the flap is opened, the adhesive portion is revealed.

7. Claims 2-4 and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Morgan (4,301,919) in view of Hillemann et al. (2003/0211268).

Morgan discloses an indicia **14**, **16**; a holder unit **12**; and a display unit **20** having a pocket portion. However, the display unit does not have a tab portion. Hillemann et al. teaches that it was known to provide a transparent display with a tab having a reusable adhesive in order to protect the contents of the display by releasably sealing them inside the display. It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the display disclosed by with a tab having an adhesive portion in order to protect the contents of the display by releasably sealing them inside the display.

Regarding claims 3 and 9, the recitation that the indicia has two sets of indicia separated by a line does not patentably define over Morgan because it has been held that patentable novelty cannot be principally predicated on mere printed matter and arrangements thereof, but must reside basically in physical structure. *In re Montgomery*, 102 USPQ 248.

Regarding claim 4, Morgan discloses a concealed holder field (below slot **24**) and a displayed holder field (above slot **24**).

Regarding claim 10, the holder **12** disclosed by Morgan is rigid and has two die cut tabs **24** cut into the holder.

Response to Arguments

8. Applicant's arguments filed August 25, 2005 have been fully considered but they are not persuasive.

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Applicant alleges that the claims are patentably distinguishable from Morgan '919, Mayer '248 and Hillemann et al., but Applicant does not explain why this is so. Applicant does not allege that the rejection set forth by the Examiner fails to account for any of the claim limitations. Further, Applicant does not show that the Examiner's motivation for making the proposed combinations is improper. Rather, Applicant alleges that each of the references used by the Examiner are non-analogous art.

It has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, Morgan, Mayer, Hillemann et al. and the instant invention are in the same field of endeavor, namely, the provision and use of sheets of indicia. Morgan and Hillemann are concerned with protecting such sheets, as is the instant invention. It is not relevant that Morgan, Mayer, Hillemann and Applicant intend different uses for their respective sheets.

Regarding Mayer, Applicant alleges that "Mayer does not teach hidden instructional indicia for instructing the user in the proper use of the invention." On the contrary, Fig. 1A of Mayer shows the instructional text: "Please Place Post-It Here." This instructional text will, of course, be hidden when the user does, in fact, place a Post-It there.

Applicant also alleges that Hillemann is non-analogous art. Applicant appears to have confused the goal of an invention with its field of endeavor, and concluded that because Hillemann and the instant invention have different goals, they must also be in different fields of endeavor. But that is not correct. Within a given field of endeavor (e.g., using envelopes to

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protect sheets of paper) there can be, and are, many different goals and intended uses for the various inventions in that field. If Applicant's contention were correct, there would be as many fields of endeavor as there are patents.

Conclusion

9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

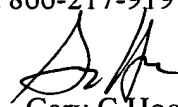
A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gary C. Hoge whose telephone number is (571) 272-6645. The examiner can normally be reached on 5-4-9.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lesley Morris can be reached on (571) 272-6651. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Gary C Hoge
Primary Examiner
Art Unit 3611

gch